

REMARKS

The following remarks are submitted to address the issues raised in the Office Action mailed March 15, 2004.

Claims 8-10, 13 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,786,106 to Armani (hereinafter "Armani") in view of United States Patent No. 5,884,195 to Gomez (hereinafter "Gomez"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Armani in view of Gomez and in further view of United States Patent No. 5,871,272 to Sharrah (hereinafter "Sharrah"). Claim 20 stands rejected as under 35 U.S.C. § 103(a) as being unpatentable over Armani and Gomez and further in view of United States Patent No. 4,499,525 to Mallory (hereinafter "Mallory").

Applicant has amended claim 8 to include a recitation wherein the power source and the source of illumination are connected in a closed circuit, the closed circuit being located entirely within the power unit housing. Support for this amendment is found in the specification on page 14, lines 16-23 through page 15, lines 1-7 and in Figure 3. Moreover, the switch disclosed in Figure 3 is not required in every embodiment of a closed circuit as explained on page 15, lines 5-7 of the specification.

Claims 8-10, 13, and 15 and 35 U.S.C. § 103(a)

The rejection of claims 8-10, 13, and 15 as being unpatentable under 35 U.S.C. § 103(a) over Armani in view of Gomez is respectfully traversed.

Applicant has amended claim 8 of the application to include a recitation "wherein the power source and the source of illumination are connected in a closed circuit, the closed circuit being located entirely within the power unit housing." This amendment excludes the integrated power source units disclosed in Armani. Although the power source and the source of illumination in Armani are located within the power unit housing, the closed circuit responsible for current flow from the power source to the illumination source is not located entirely within the power unit housing. The closed circuit connecting the power source with the source of illumination in Armani is located

within the power unit housing and the supplemental feature cartridge that docks with the power unit housing.

Figure 4 in Armani is a circuit diagram for the battery pack disclosed therein. According to the diagram, the lamp 74 within the power unit housing is connected at one end to the negative terminal of the power source. The remaining connection of the lamp leads to an electrical contact 24. In order for the lamp 74 to receive current for illumination, the circuit containing the lamp must be completed. To complete the circuit, the electrical contact 24 must come into contact with a source of positive voltage.

The requisite positive voltage source is provided through the supplemental feature cartridge that is operable to dock with the power unit housing. Figures 1 and 9 and the specification (Column 4, lines 64-67; Column 5, lines 1-7; and Column 6, lines 36-43) provide the following description of how the battery pack and supplemental feature cartridge dock to complete a closed circuit operable to illuminate the lamp 74.

When the supplemental feature cartridge is fully inserted into the battery pack, contact 22 of the battery pack makes contact with contact 86 on the underside of the supplemental feature cartridge to connect the ground or negative voltage between the battery pack and cartridge. Moreover, contact 24 of the battery pack makes contact with contact 84 to connect the lamp 74 with a lamp switch 80. To complete the circuit, contact 26 of the battery pack makes contact with contact 82 of the supplemental feature cartridge to connect the positive voltage between the battery pack and the cartridge. With the appropriate contacts established, the supplemental feature cartridge and can now receive power from or source power to the battery pack. When switch 80 on the cartridge is pressed, contact 84 receives a positive voltage and which turns on the lamp 74 within the battery pack.

As demonstrated by the foregoing description, the closed circuit connecting the illumination source with the power source is not located entirely within the power source unit housing. The complete circuit is shared between the power source unit housing and the supplemental feature cartridge.

The illumination source within the power source unit housing disclosed in Armani is inoperable without the presence of the supplemental feature cartridge to complete the closed circuit connecting the power source to the illumination source. In the present

invention, however, the closed circuit connecting the power source and the illumination source is located entirely within the power unit housing which precludes the need for additional circuitry contained in a supplemental feature cartridge.

Moreover, modification or combination of Armani with another reference under § 103(a) to arrive at a power source unit wherein the power source and source of illumination are connected in a closed circuit, the closed circuit being located entirely within the power source unit housing, is insufficient to render the claims of the present application obvious. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.¹ The court in *Ratti* reversed the rejection holding the “suggested combination of the references would require a substantial reconstruction and redesign of the elements in [the primary] reference as well as a change in the basic principle under which the [primary reference] construction was designed to operate.”²

Modifying Armani to display a closed circuit connecting the power source to the illumination source, the closed circuit being located entirely within the power unit housing would change the principle of operation of the power source unit disclosed in Armani. The principle of operation of the power source unit with reference to the illumination source in Armani is predicated upon the presence of the supplemental feature cartridge. As previously discussed, without the supplemental feature cartridge, illumination source of the power source unit is inoperable. Removal of the supplemental feature cartridge from Armani and subsequent modification to a closed circuit entirely within the power unit housing “would require substantial reconstruction and redesign of the elements in Armani as well as change the basic principle under which Armani construction was designed to operate.”³

In addition to changing the principle of operation, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.⁴ The intended

¹ *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

² *Id.* at 813.

³ *Id.*

⁴ *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

purpose of Armani is to provide a battery pack that offers features in addition to a power source. Armani accomplishes this intended purpose through the incorporation of supplemental feature cartridges into the power source unit. Modification of Armani to display a power source unit consistent with that of the present invention would obviate the need for the supplemental feature cartridge in the operation of the illumination source. Obviating the need for the supplemental feature cartridges in modifying Armani to arrive at a power source unit of the present invention would preclude the power source unit's ability in Armani to offer additional features, thereby rendering it unsatisfactory for its intended purpose.

Furthermore, Gomez does not cure the deficiencies of Armani. Gomez is directed to a grounding assembly for a cellular telephone wherein the grounding assembly is integrated into a battery module for the telephone. This assembly permits an easy, one-handed method of switching the mode of the cellular telephone from an operational mode to a test mode. Gomez does not address aspects of a power source unit of the present invention.

For the foregoing reasons, Applicant respectfully requests that the Examiner withdraw the rejection of claim 8. As claims 9-10 depend from and further limit claim 8, Applicant respectfully asserts that these claims are also patentable and respectfully requests that the Examiner withdraw the rejection of these claims. Moreover, in that Armani fails to disclose a power source unit reciting all the limitations of the present invention, Applicant respectfully requests that the Examiner withdraw the rejection of claims 13 and 15 as well.

Claim 11 and 35 U.S.C. § 103(a)

The rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Armani and Gomez in further view of Sharrah is respectfully traversed.

Sharrah is directed to a flashlight with a rotatable lamp which is not adaptable to a telecommunications device such as a phone or cellular phone.

Claim 11 depends from claim 8. As discussed above, Applicant respectfully submits that claim 8 is patentable over Armani in view of Gomez. Moreover, Sharrah

fails to cure the deficiencies of Armani and Gomez, and Applicant respectfully submits that claim 8 is patentable over Armani and Gomez in further view of Sharrah. As claim 11 depends from claim 8, Applicant likewise respectfully submits that claim 11 is also patentable, and the Examiner is respectfully requested to withdraw the rejection.

Claim 20 and 35 U.S.C. § 103(a)

The rejection of claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Armani and Gomez in further view of Mallory is respectfully traversed.

Mallory is directed to a portable flashlight containing circuitry that allows the flashlight to have constant illumination output over the lifetime of the batteries.

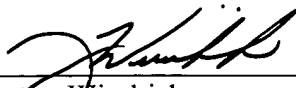
Claim 20 depends from claim 8. As previously discussed, Applicant respectfully submits that claim 8 is patentable over Armani in view of Gomez. In addition, Mallory fails to cure the deficiencies of Armani and Gomez, and Applicant respectfully submits that claim 8 is patentable over Armani and Gomez in further view of Mallory. As claim 20 depends from claim 8, Applicant likewise respectfully submits that claim 11 is also patentable, and the Examiner is respectfully requests to withdraw the rejection.

CONCLUSION

For the foregoing reasons, a favorable Office Action is respectfully solicited. The Examiner is respectfully invited to contact J. Clinton Wimbish, at (336) 607-7399 to discuss any matter relating to this application.

Respectfully submitted,

Date: 8/10/04


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